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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,115	08/03/2001	Ralf Stolte	US20 00 3848	7839

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EXAMINER

LYONS, MICHAEL A

ART UNIT PAPER NUMBER

2877

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,115

Applicant(s)

STOLTE ET AL.

Examiner

Michael A. Lyons

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 16, 2003 has been entered.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-2, and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kringlebotn et al (WO 98/36252).**

Regarding claim 1, Kringlebotn (Fig. 1) discloses a Fabry-Perot filter 8 acting as a wavemeter unit, at least one fiber Bragg grating 5 providing an absolute wavelength reference, and a signal processing unit 11 to process the received reference and measurement beams.

As for claim 2, the fiber Bragg grating 5 is characterized by a known Bragg wavelength (abstract).

As for claim 5, the Fabry-Perot filter, acting as a wavemeter unit, can also be a tuneable interference filter (Page 3, line 32).

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Further regarding claims 1, it has been held that the recitation that an element is “adapted for” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Further regarding claim 2, it has been held that the functional “whereby” statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

**Claims 7-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kringlebotn et al (WO 98/36252).**

Regarding claim 7, Kringlebotn discloses a broadband light source 1, a wavelength-determining unit as described regarding claim 1, a pair of detectors 7, 10 for receiving an optical signal, and a signal processing unit 11, wherein this single unit can act as an evaluation device for both the wavelength-determining unit and as a second evaluation unit for the device.

Regarding claim 8, Kringlebotn discloses a broadband light source 1, a wavelength-determining unit as described regarding claim 1, a pair of detectors 7, 10 for receiving an optical signal, and a signal processing unit 11 to process and evaluate the received signals.

Regarding claim 9, while Kringlebotn fails to disclose a method for the operation of the device, it does disclose the claimed characteristics of the applicants’ invention; therefore, the method can be applied to the device of Kringlebotn to achieve the desired result.

Further regarding claims 7-8, it has been held that the recitation that an element is “adapted for” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

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In addition, claims 7 and 8 refer to a device for measuring a device under test (DUT). The majority of the claim regarding a DUT is mentioned either in the preamble of the claim or in an "adapted for" clause. By being located within these parts of the claim, the DUT carries no patentable weight. If the claims were amended so that the DUT carries patentable weight, however, the claims may be interpreted as a new invention separate from the wavelength-determining unit initially claimed and would be subject to a restriction requirement.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kringlebotn et al (WO 98/36252).**

As for claims 3 and 4, the correlation unit and exact programming of the evaluation unit is not disclosed. Official notice is taken as to the inclusion of the correlation unit and the programming of the evaluation unit, however, as basic correlation and programming is required in order to facilitate any result gathering and analysis of the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a correlation unit and to program an evaluation unit for the reasons discussed above.

As for claim 6, a gas absorption cell is not disclosed. Official notice is taken as to the use of a gas absorption cell as an absolute wavelength reference device, however, because the gas absorption cell will absorb a known wavelength of light, allowing that wavelength to be used as

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an exact reference for the device, and therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a gas absorption cell as an absolute wavelength reference.

**Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kringlebotn et al (WO 98/36252).**

Regarding claim 10, Kringlebotn's device, while not teaching a method for using the device, does disclose an apparatus as described above that the claimed invention reads on. Therefore, Kringlebotn's device can be used for the necessary wavelength determination as claimed. The device, however, fails to explicitly disclose a signal evaluation unit with the ability to provide corrected wavelength values as claimed. Official notice is taken as to the programming of an evaluation unit to perform any necessary or desired correction calculations to ensure proper results from the device, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to make such programming modifications as necessary for the reasons noted above.

#### ***Response to Arguments***

Applicants' arguments filed May 16, 2003 have been fully considered but they are not persuasive. As stated in previous Office Actions, while the applicants' arguments may indeed be valid over the prior art of Kringlebotn, the amended claims still contain functional language that carry no patentable distinction. The functional language, as written, only discloses a function that the elements can perform, not functions that the elements have to perform as would be generated by claim language in the "means plus function" format of U.S.C. 112, 6<sup>th</sup> paragraph. The current function language gives any limitations in the claims related to the clause no

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patentable distinction and renders the claims as a listing of the elements contained therein.

Kringlebotn, as described above, discloses these elements, making the claims in their current form read on the prior art.

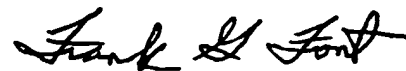
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Lyons whose telephone number is 703-305-1933.

The examiner can normally be reached on Monday thru Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G Font can be reached on 703-308-4877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0935.

MAL  
August 27, 2003



Frank G. Font  
Supervisory Patent Examiner  
Technology Center 2800